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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/423,619 11/15/99 SEITER

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EXAMINER

QM12/0125

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ART UNIT

PAPER NUMBER

3728

#5

DATE MAILED:

01/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/423,619

Applicant(s)

Selter

Examiner

Troy Arnold

Group Art Unit

3728



☒ Responsive to communication(s) filed on Dec 6, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 26-30 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 26-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3728

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast in view of Wang. Pendergast teaches all the limitations of claim 26 except cushioned layers specifically located in the metatarsus/tarsus transition area and the metatarsus/heel transition area, each (first, second, and third) cushioned layer being divided into individual fields. In Fig 5, Wang teaches cushion areas on an insole which appear to correlate to the metatarsus/tarsus transition area and the metatarsus/heel transition area. It would have been obvious in view of Wang to incorporate cushions specifically in these areas, or to divide cushion 24 of Pendergast into front and back cushion segments (which would then correspond to these two areas), for the purpose of ensuring a more effective, therapeutic and accurately supportive insole surface. Regarding the individual fields, Pendergast does teach a cushioned layer 25-34 in the forefoot joint area which is divided into individual fields. Pendergast teaches the cushioned layers being located at support areas; it appears that the insole of Pendergast would positively affect the contraction of the musculature of the foot, which would serve to aid the venous outflow

Art Unit: 3728

of blood. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the other areas, the metatarsus transition and metatarsus heel areas, of the insole of Pendergast for the purpose of providing the same benefits as are provided by the division on the forefoot area. Pendergast teaches all the limitations of claim 27; see item 20 in Fig 1.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 27 above, and further in view of Mauch or Sawyer. Both Mauch and Sawyer teach substantially oval-shaped cushion layers in the heel area. See Mauch, Fig 1, item 8. See Sawyer, Fig 1, item a. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the heel cushion layer of Pendergast oval-shaped for a variety of art conventional reasons, such as comfort under the heel. (See the cited art not relied upon for a number of different variations in shape and orientation of insole cushion layers.)

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 27 above, and further in view of Shames. Shames teaches a sickle-shaped insole cushion layer 26 in the plantar arch area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a sickle-shaped cushion layer in the plantar arch area of Pendergast for the purpose of providing more arch support to the foot.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast as applied to claim 29 above, and further in view of Fenton or Alianiello. Both Fenton and Alianiello teach cushioned layers recessed in a sole base body. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recess the cushion layers of

Art Unit: 3728

Pendergast into a sole base body, if the sole base body 18 were thicker, for the purpose of better securing the layers to the base body, or for modulating the total amount of cushioning effect provided by the layers.

### ***Response to Arguments***

Applicant's arguments filed have been fully considered but they are not persuasive. If the applicant is certain that his structure as claimed will "positively affect a contraction of the musculature of the foot, serving thereby to aid the venous outflow of blood," then it will be clear that the structure of Pendergast will have the same effect. It should be noted as well that this phrase is entirely functional and recites no structural limitations. Regarding the positions of the cushion layers, it is maintained that Pendergast either teaches cushion layers in the areas specifically claimed, or it would have been obvious in view of the other references such as Wang, to put one there.

Receipt of the applicant's brochure and sample is acknowledged.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


Art Unit: 3728

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Troy Arnold whose telephone number is (703)305-0621. The Examiner can normally be reached Monday through Friday from 9:00 am until 5:00 pm EST. Any questions of a general nature pertaining to the application can be directed to the group receptionist whose number is (703) 308-1148.

TGA

January 22, 2001

  
Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700